

### **REMARKS**

Claims 1-20 are pending in the present application. Claims 1, 4, 9, 10, 13 and 18-20 have been amended herewith. Reconsideration of the claims is respectfully requested.

#### **I. 35 U.S.C. § 103, Obviousness**

The Examiner rejected Claims 1-8, 10-17 and 19-20 under 35 U.S.C. § 103 as being unpatentable over Richard et al. (5,812,818). This rejection is respectfully traversed. With respect to Claim 1, Applicants urge that the cited reference does not teach or otherwise suggest the claimed steps of (i) repeatedly translating and retranslating the original source language text between the source language and a target language until a current source language text is not reasonably equivalent to the original source language text or until an iteration threshold is reached; or (ii) identifying the translation as low quality if the current source language text is not reasonably equivalent to the original source language text. The cited reference merely makes vague reference to a single translate-back step for the purpose of checking for accuracy. The Examiner states that Richards does not teach where the back and forth translation is iterated/repeated, but takes Office Notice that iterating a process a number of times is a common practice and that this would have been obvious per Richard's teaching for the purpose of getting a more accurate assessment of the system. Applicants urge two-fold error in such rejection, as follows.

First, as stated by the Federal Circuit, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed

invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). "[w]hen determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" *See In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)). It is urged that the Examiner's Official Notice is insufficient in establishing obviousness, as there is nothing in the cited art to suggest any desire to modify the teachings contained therein to include iterative back and forth translations. For example, as can be seen in Figure 17 of Adler (US 5,812,818), data being input to the translate block 654 comes from either a modem, a facsimile or hardcopy (blocks 606, 620 and 640). It is not seen how this system could even be modified to achieve an iterative back and forth translation due to this structure.

The Examiner relies on Adler's Claim 15 as teaching a single translate back to determine translation accuracy. It is respectfully submitted that this cursory statement to check accuracy does not teach or otherwise suggest any desire to modify the teachings contained therein to include an iterative process for such back and forth translation. A bare statement of checking the accuracy of a translation does not provide such motivation. The fact that a prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Although a device may be capable of being modified to run the way [the patent applicant's] apparatus is claimed, there must be a suggestion or motivation *in the reference* to do so. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Quite simply, the reference provides no motivation to modify the teachings contained therein to include an iterative back and forth translation, as a single translate back is all that is required by Adler to check the accuracy of the translation.

This is further evidenced by the fact that other than the hindsight gleaned from the present invention, there is no indication in the cited reference of how such iterative back

and forth translation would improve the translation accuracy checking. The only reason given by the Examiner for combining the alleged well-known iterative technique with the Adler teaching is "for getting a more accurate assessment of the system", and yet until the present invention/specification it was not known that such an iterative technique would provide a more accurate assessment of the translating operation. It is improper to use the present invention and specification as providing the motivation to modify the Adler teachings, and it is *only* through the teachings of the present invention/specification that such an iterative back and forth translation can be used to improve assessment of translation quality. As stated by the Federal Circuit, it is error to reconstruct the patentee's claimed invention from the prior art by using the patentee's claims as a "blueprint". When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). The Examiner must be using Applicants' own patent specification as providing the motivation to modify the Adler teachings, as that is the only mention of using iterative translations for improving assessments of translation quality. Thus, impermissible hindsight is being used – which is error.

Claim 1 is thus shown to have been erroneously rejected, as (1) there is no suggestion or motivation in the reference to modify the teachings contained therein in accordance with the present invention, and (2) impermissible hindsight is being used in the rejection of such claim.

To further emphasize that there was no motivation to modify Adler per the claimed invention, as Adler did not contemplate that iterative translations could be used to assess the quality of translation, Applicants have amended Claim 1 to more particular highlight that the present invention is not merely an iterative process using an iteration counter, but rather is a translation assessment technique that uses a quality indicator for determining whether to continue loop iterations. Specifically, and as amended, Claim 1 includes a two-fold determination of whether to continue the translate/retranslate loop. In addition to using an iteration threshold as part of such determination, a language equivalency factor is also used in such determination. The cited reference does not teach or otherwise suggest use of a language equivalency factor to determine whether to

perform a translation. Thus, it is further urged that Claim 1 is not obvious in view of the cited reference.

Applicants traverse the rejection of Claims 2, 3, 10 and 19 for similar reasons to those given above with respect to Claim 1.

As to Claim 4, Applicants initially traverse for similar reasons to those given above with respect to Claim 1 and the impermissible use of hindsight being used in rejecting such claim, as otherwise there was no motivation to modify the teachings of Adler in accordance with the presently claimed invention. To further emphasize this 'no motivation'/'improper hindsight' reasoning, Applicants have amended Claim 4 to expressly recite that a determination is made on whether  $SHLx_i$  is reasonably equivalent to  $SHLx_0$  as a part of the iterative loop processing. The cited reference does not teach, suggest or otherwise provide any motivation to modify the teachings contained therein to include such determination being made in an iterative loop process, and thus amended Claim 4 is further shown to not be obvious in view of the cited reference.

Applicants traverse the rejection of Claims 5-8 for reasons given above with respect to Claim 4 (of which Claims 5-8 depend upon).

Applicants traverse the rejection of Claims 10-12 for similar reasons to those given above with respect to Claim 1.

Applicants traverse the rejection of Claims 13-17 for similar reasons to those given above with respect to Claim 4.

Applicants traverse the rejection of Claim 19 for similar reasons to those given above with respect to Claim 1.

Applicants traverse the rejection of Claim 20 for similar reasons to those given above with respect to Claim 4.

Therefore, the rejection of Claims 1-8, 10-17 and 19-20 under 35 U.S.C. § 103 has been overcome.

## **II. Objection to Claims**

The Examiner stated that Claims 9 and 18 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response,

the claims have been rewritten accordingly, and Applicants graciously acknowledge the allowability of such claims.

### III. Conclusion

It is respectfully urged that the subject application is patentable over the cited reference and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



Duke W. Yee  
Reg. No. 34,285  
Wayne P. Bailey  
Reg. No. 34,289  
Yee & Associates, P.C.  
P.O. Box 802333  
Dallas, TX 75380  
(972) 385-8777  
Attorneys for Applicants